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## **II. REMARKS**

Claims 1, 2 and 4-18 are currently pending in the application. The Office Action rejected Claims 1, 2 and 4-18. By the foregoing amendments, Applicant amended Claim 14 to further clarify the claimed invention and expedite receiving a notice of allowance. Pursuant to 37 C.F.R. § 1.118, no new matter is introduced by these amendments. Applicant believes that Claims 1, 2 and 4-18 are now in condition for allowance.

Please note that Applicant's remarks are presented in the order in which the issues were raised in the Office Action for the convenience and reference of the Examiner. In addition, Applicant requests that the Examiner carefully review each of the references discussed below to ensure that Applicant's understanding and discussion of the references, if any, is consistent with the Examiner. Further, the following remarks are not intended to be an exhaustive enumeration of the distinctions between any particular reference and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and that reference.

### **Response to the First Section 103 (a) Rejection**

The Office Action rejected Claims 1, 2, 4-6, 14 and 15 under 35 U.S.C. § 103 (a) as being unpatentable over applicant's admitted prior art in view of U.S. patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.; and Dow Corning Data Sheet Q3-6093. The Office Action states that Applicant stated that the use of double sided adhesive tape to attach backboards to a frame structure

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is old (page 2, lines 3-17). The Office Action also stated that Applicant admits that the use of double sided tape was inadequate in that it was costly and time consuming (page 2, lines 9-14). The Office Action stated that a workman in the art in view of this deficiency would have looked for other equivalent but better means of attachment in the sporting goods adhesive art.

The Office Action asserts that the workman would have noted the art of the Chung, Hankele and Skedleski patents because the Office Action asserts that each of these patents provide similar equivalent adhesive attachment means for sporting goods. In particular, the Office Action states that the Chung patent discloses that the "attachment of sports articles can be secured by suitable and conventional means" which includes using "silicone glue." Page 4, lines 29-30. The Office Action states the Hankele patent discloses the use of any of the adhesives known in the art, such as "epoxy or silicone adhesives." Page 2, lines 34-37. The Office Action also states that the '316 Skedleski patent discloses using a "suitable means of attachment such as silicone adhesive" and using a primer to improve adhesion. Page 1, lines 46-49, 61-64. The Office Action further states the '314 Skedleski patent discloses the desirability of the silicon adhesive having a cushioning effect. Page 2, lines 60-64.

The Office Action asserts that the art of the Chung, Hankele and Skedleski patents clearly shows that those knowledgeable in the sporting goods adhesion art were aware of silicon adhesives and their suitability and advantages when considering cost, cushioning and superior adhesive qualities where sporting goods will be used in severe conditions such as outdoors.

The Office Action concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a silicone adhesive as taught by the Chung, Hankele or

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Skedleski patents in order to lower production costs and manufacture a more durable backboard in order to increase the player's satisfaction with the product. The Office Action also asserts that it would have been obvious to one of ordinary skill in the art to have sought and selected the most suitable adhesive from among the equivalent silicone adhesives available including Dow Q3-6093 by the routine optimization expected by one of skill in the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). The Office Action stated that it should be noted that no unexpected or extraordinary results were obtained by Applicant in using the silicone adhesive. The Office Action asserts that Applicant was merely following the recommended procedure for using the adhesive.

Applicant respectfully traverse this rejection because neither Claims 1, 2, 4-6, 14 or 15 are disclosed, taught or suggested by the Chung, Hankele and Skedleski patents or the Dow Corning Data Sheet Q3-6093, either alone or in combination.

U.S. Patent No. 6,056,622 issued to Chung

In contrast to the Examiner's assertion, the Chung patent does **not** disclose that the "attachment of sports articles can be secured by suitable and conventional means" which includes using "silicone glue." Instead, the Chung patent discloses:

The **parts of ball part 60** are thereafter **secured together by suitable and conventional means, such as an adhesive like clear silicone glue with a chemical composition, methoxy polydimethylsiloxane, which is thereafter allowed to cure about one day and at room temperature.**

Col. 4, lines 28-32 (emphasis added).

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In greater detail, the Chung patent discloses a ball with unpredictable bounce characteristics. In particular, the Chung patent states the ball part 60 comprises a ball of the high bouncing type, such as ball 30 of Figure 1. Col. 3, lines 65-67. The Chung patent explains:

Ball part 30 comprises a conventional high bouncing type ball of the type that might also be utilized to play, practice or train with for baseball. Ball part 30 is made of an elastic rubber (silicone, thermoplastic elastomer, or the like) and is referred to an high bouncing because when dropped from a height of 149 cm onto a marble floor, ball 30 will rebound at about 112 cm.

Col. 3, lines 21-27 (emphasis added).

Thus, the Chung patent discloses a conventional high bouncing type ball that may be used to play baseball and is constructed from elastic rubber. The Chung patent also discloses that parts of the elastic rubber, high bouncing type ball may be secured together using an adhesive like clear silicone glue, which is allowed to cure about one day and at room temperature. Therefore, the Chung patent teaches using an adhesive like clear silicone glue to secure together parts of an elastic rubber, high bouncing type ball.

In contrast, Claim 1 is directed towards a basketball backboard assembly including a rigid frame and a rigid acrylic backboard, neither of which is constructed from elastic rubber. In addition, Claim 1 positively recites “a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface, wherein the elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball.” The Chung patent, on the other hand, discloses using an adhesive like clear

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silicone glue to secure together parts of an elastic rubber, high bouncing type ball. The Chung patent does **not** teach, suggest or disclose either (1): using clear silicone glue to adhere two separate, rigid members, such as a backboard frame and an acrylic backboard; or (2) that the silicone glue will provide sufficient adhesion and flexibility to an acrylic backboard and frame structure that will allow it to be used in the game of basketball. Accordingly, the Chung patent does **not** teach, suggest or disclose each and every element of Claim 1.

U.S. Patent No. 3,809,401 issued to Hankele

The Hankele patent discloses a hockey stick with a flexible net for catching and stopping a puck in both the forehand and backhand position. Col. 1, lines 41-43. In particular, the Hankele patent states that the hockey stick includes a handle 12, a blade 14 and a net 16. The Hankele patent also states “[a] rod 18 extends across the elbow between the handle 12 and the blade 14. Rod 18 has one end 20 that is secured in a hole adjacent the toe 22 of blade 14. A second end 24 of the rod is secured in a hole in handle 12. The ends 20 and 24 are secured in place by a pressed fit, or if desired, an adhesive can be used to additionally secure the ends in place.” Col. 2, lines 12-18 (emphasis added). The Hankele patent further states “[t]he net 16 has an upper edge that is secured to the rod 18. This securement is accomplished by forming loops 26 in the top strands of the net, and adhesively securing these loops to the rod 18.” Col. 2, lines 23-26 (emphasis added). Additionally, the Hankele patent states “[t]he net also includes free ends 28 which are secured in holes in the handle 12 and blade 14. The free ends 28 are adhesively secured in place within the holes.” Col. 2 lines 26-29 (emphasis added). The Hankele patent states “[t]he rod 18, the loops 26 and the ends 28

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of the net 16 can be adhesively secured in place by any of the adhesives known in the art, such as epoxy or silicone adhesives.” Col. 2, lines 34-37 (emphasis added).

Accordingly, the Hankele patent discloses that adhesives known in the art, such as epoxy or silicone adhesives, may be used to: (1) additionally secure the ends of a rod 18 that are press fit into a hole in the toe of the blade and into a hole in the handle of a hockey stick; (2) adhesively secure loops 26 in the top strands of a net 16 to the rod 18; and (3) adhesively secure the free ends 28 of the net 16 in holes in the handle 12 and blade 14. Therefore, the Hankele patent teaches using adhesives that are known in the art, such as epoxy or silicone adhesives, to further secure the ends of a rod into holes in a hockey stick, secure loops in the top of a net to a rod, and secure the free ends of the net into holes in the hockey stick.

Claim 1, on the other hand, positively recites, inter alia, “a backboard frame structure having a bonding surface; an acrylic backboard having a bonding surface; and a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface, wherein the elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball.” The Hankele patent does not teach, suggest or disclose, for example, a catalyzed elastomeric adhesive sandwiched between a frame bonding surface and a backboard bonding surface, or an elastomeric adhesive that provides sufficient adhesion and flexibility to an acrylic backboard and frame structure bonding surface to be used in the game of basketball. Accordingly, the Hankele patent does not teach, suggest or disclose each and every element of Claim 1.

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U.S. Patent Nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.

The Skedleski patents are directed towards a safety tip of a water sport board, such as a surf board, for reducing or preventing injury to a user upon impact with the nose portion of the board. For example, the '316 patent states "a surfboard tip cover is provided which comprises a generally hollow, substantially V-shaped member which is made of a relatively soft, flexible and resilient silicone material." Col. 1, lines 33-37 (emphasis added). The '316 patent also states "[t]he tip cover is preferably constructed of a flexible and resilient liquid injected silicone." Thus, the Skedleski patents are directed towards a relatively soft, flexible and resilient silicone material that is used that is used as a safety device.

The Skedleski patents also state that "[t]he tip cover is fixedly secured to the top portion of the board, for example, by silicone adhesive between the body portion and the extension portions and the parts of the board that they overlay." Col. 1, lines 55-59 of the '314 patent. The '316 patent states that "[i]t is preferable that any space left between the tip of the board and the apex of the cover be filled with the silicone adhesive to provide an even further cushioning effect." Col. 2, lines 59-63. Thus, the Skedleski patents disclose using a silicone adhesive to attach the relatively soft, flexible and resilient silicone tip cover to the sharply pointed nose of a water sport board. The Skedleski patents also disclose that any space between the tip of the board and the apex of the cover may be filled with silicone adhesive to provide an even further cushioning effect. Therefore, the Skedleski patents disclose using a silicone adhesive to attach a relatively soft, flexible and resilient silicone material to the hard, sharp point of a water sports board as a safety device.

In contrast, Claim 1 is directed towards a basketball backboard assembly including a rigid

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frame and a rigid acrylic backboard, neither of which is constructed from a relatively soft, flexible and resilient silicone material. Additionally, Claim 1 positively recites, inter alia, “a backboard frame structure having a bonding surface; an acrylic backboard having a bonding surface; and a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface, wherein the elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball.” The Skedleski patents do **not** teach, suggest or disclose, for example, a catalyzed elastomeric adhesive sandwiched between a frame bonding surface and an acrylic backboard bonding surface. In addition, the Skedleski patents do **not** teach suggest or disclose an elastomeric adhesive that provides sufficient adhesion and flexibility to an acrylic backboard and frame structure bonding surface to be used in the game of basketball. Accordingly, the Skedleski patents do **not** teach, suggest or disclose each and every element of Claim 1.

#### Claim 1

Applicant respectfully traverses this rejection because none of the cited references, either alone or in combination, teach, suggest or disclose each and every limitation of Claim 1. For example, none of the cited references disclose a basketball backboard assembly sized and configured for playing the game of basketball. In contrast, the cited references disclose a ball with an unpredictable bounce, a hockey stick, and a water sport board safety tip. Because none of the references teach, suggest or disclose a basketball backboard assembly sized and configured for playing the game of basketball, Applicant requests that this Section 103 (a) rejection be withdrawn.



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In addition to none of the cited references teaching, suggesting or disclosing a basketball backboard assembly sized and configured for playing the game of basketball, none of the cited references teach, suggest or disclose either a backboard frame structure having a bonding surface or an acrylic backboard having a bonding surface. In fact, none of the cited references disclose any type of basketball related structures or are even used in connection with basketball. Thus, Applicant requests that this Section 103 (a) rejection be withdrawn because none of the references, either alone or in combination, teach, suggest or disclose a backboard frame structure having a bonding surface or an acrylic backboard having a bonding surface.

In addition to none of the cited references teaching, suggesting or disclosing a basketball backboard assembly sized and configured for playing the game of basketball, a backboard frame structure having a bonding surface or an acrylic backboard having a bonding surface; none of the cited references teach, suggest or disclose a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface or an elastomeric adhesive providing sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball. As discussed above, none of the cited references are used in connection with basketball. In contrast, the references are directed towards: (1) an adhesive like clear silicone glue to secure together parts of an elastic rubber, high bouncing type ball (the Chung patent); (2) using adhesives that are known in the art, such as epoxy or silicone adhesives, to further secure the ends of a rod into holes in a hockey stick, secure loops in the top of a net to a rod, and secure the free ends of the net into holes in the hockey stick (the Hankele patent); and (3) using a silicone adhesive to attach a relatively soft, flexible and resilient silicone material to the hard, sharp

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point of a water sports board as a safety device (the Skedelecki patents). Because none of the references teach, suggest or disclose a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface or the elastomeric adhesive providing sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball, Applicant requests that this Section 103 (a) rejection be withdrawn.

There is also no suggestion that any of the cited references can be properly combined to support this Section 103 (a) rejection. The courts have made clear that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion or incentive supporting the combination. See, e.g., ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). In this case, there is no teaching, suggestion or incentive to combine an adhesive like clear silicone glue to secure together parts of an elastic rubber, high bouncing type ball; an adhesive, such as epoxy or silicone adhesives, to further secure the ends of a rod into holes in a hockey stick, to secure loops in the top of a net to a rod, and to secure the free ends of the net into holes in the hockey stick; and/or a safety device that uses a silicone adhesive to attach a relatively soft, flexible and resilient silicone material to the hard, sharp point of a water sports board. Accordingly, Applicant requests that this Section 103 (a) rejection be withdrawn because there is no teaching, suggestion or incentive supporting the combination of these references.

Furthermore, the cited references teach away from Claim 1 which positively recites “a catalyzed elastomeric adhesive that is sandwiched between the frame bonding surface and the backboard bonding surface, wherein the elastomeric adhesive provides sufficient adhesion and

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flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball.” For example, the cited references disclose using: (1) an adhesive to secure together parts of an elastic rubber, high bouncing ball; (2) an adhesive to further secure the ends of a rod into holes in a hockey stick, to secure loops in the top of a net to a rod, and to secure the free ends of the net into holes in the hockey stick; and (3) an adhesive to attach a relatively soft, flexible and resilient silicone material to the hard, sharp point of a water sports board. Thus, the cited references teach using an adhesive to connect different materials for different purposes than the claimed basketball backboard assembly. Therefore, because the cited references teach away from the invention recited in Claim 1, Applicant requests that this Section 103 (a) rejection be withdrawn.

In summary, neither the Chung, Hankele or Skedleski patents, nor the Dow Corning Data Sheet Q3-6093, either alone or in combination, teach, suggest or disclose each and every limitation recited in Claim 1. In addition, independent Claim 14 is patentable in view of the cited references at least because it includes limitations similar to those discussed above in connection with Claim 1. Further, Claims 2, 4-6 and 15 are also patentable in view of the cited references at least because these claims are dependent upon independent Claims 1 and 14 respectively.

#### Response to the Second Section 103 (a) Rejection

The Office Action rejected Claims 8-10 and 16-18 under 35 U.S.C. § 103 (a) as being unpatentable over the prior art as applied to Claims 1 and 14 in view of Official Notice. The Office Action stated that Official Notice is taken that the use of glass bead spacers is well known in the adhesive art (Spherglass webpage & adhesion society lit review abstract). The Office Action

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concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to have employed glass beads with the device in order to maintain the proper adhesive thickness in order to insure there was proper bonding between the backboard and the frame.

Applicant respectfully traverses this rejection because Claims 8-10 and 16-18 are not rendered obvious in view of the Chung, Hankele and Skedleski patents, the Dow Corning Data Sheet Q3-6093, and/or the Official Notice taken by the Examiner. Claims 8-10 and 16-18, however, are patentable at least because they are dependent upon independent Claims 1 and 14 respectively. Accordingly, Applicant requests that this Section 103 (a) rejection be withdrawn.

Response to the Third Section 103 (a) Rejection

The Office Action rejected Claims 11 and 12 under 35 U.S.C. § 103 (a) as being unpatentable over the prior art as applied to Claim 1 in view of Official Notice. The Office Action stated that Official Notice is taken that the use of painted metal frames is well known in the basketball goal art. The Office Action concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to have employed a painted metal frame in order to provide a low cost structure that was attractive in order to increase sales.

Applicant respectfully traverses this rejection because neither Claims 11 nor 12 are rendered obvious in view of the Chung, Hankele and Skedleski patents, the Dow Corning Data Sheet Q3-6093, and/or the Official Notice taken by the Examiner. In addition, Claims 11 and 12 are patentable in view of the cited references and Official Notice taken by the Examiner at least because Claims 11

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and 12 are dependent upon independent Claim 1. Consequently, this Section 103 (a) rejection should be withdrawn.

Response to the Fourth Section 103 (a) Rejection

The Office Action rejected Claim 13 under 35 U.S.C. § 103 (a) as being unpatentable over the prior art as applied to Claim 1 in view of Official Notice. The Office Action stated that Official Notice is taken that the use of printed images on the backboard is well known in the art. The Office Action concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to have employed a printed image on the backboard to insure the proper position was maintained during the bonding operation in order to reduce the number of defective and misaligned backboards and lower total production costs.

Applicant respectfully traverses this rejection because Claim 13 is not rendered obvious in view of the Chung, Hankele and Skedleski patents, the Dow Corning Data Sheet Q3-6093, and/or the Official Notice taken by the Examiner. However, at least because Claim 13 is dependent upon independent Claim 1, Applicant requests that this Section 103(a) rejection be withdrawn.

CONCLUSION

In view of the foregoing, Applicant submits that Claims 1, 2 and 4-18 are allowable over the cited references and are in condition for allowance. Accordingly, Applicant requests that a Notice of Allowance be promptly issued.

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If any further impediments to allowance of this application remain, the Examiner is cordially invited to contact the undersigned by telephone so that these remaining issues may be promptly resolved.

Respectfully submitted,

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